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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,354	03/29/2000	Stefan P. Swierkowski	1L-10475	6131

24981 7590 06/16/2003

THE REGENTS OF THE UNIVERSITY OF CALIFORNIA
LAWRENCE LIVERMORE NATIONAL LABORATORY
PO BOX 808, L-703
LIVERMORE, CA 94551-0808

EXAMINER

NOGUEROLA, ALEXANDER STEPHAN

ART UNIT	PAPER NUMBER
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1753

DATE MAILED: 06/16/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/538,354

Applicant(s)

SWIERKOWSKI, STEFAN P.

Examiner

ALEX NOGUEROLA

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-28, 32 and 36-43 is/are allowed.
- 6) ☒ Claim(s) 1-13, 15, 18, 19, 29-31, 33 and 34 is/are rejected.
- 7) ☒ Claim(s) 14, 16, 17, 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 28 April 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Amendment

1. Applicant's amendment of April 28, 2003 does not render the application allowable.

Response to Arguments

2. Applicant's arguments filed April 28, 2003 have been fully considered but they are not persuasive. Applicant proffers that having the injection point in Simpson et al. connected to only one sample well instead of more than one sample well is hindsight reasoning. The examiner respectfully disagrees. It should be first noted that the adjectives "sample" and "waste" in "sample wells" and "waste wells", respectively, do not denote any structure, but only connote intended use. In any event, as discussed in the previous Office action, Simpson et al. provide several sample wells so several different samples may be simultaneously analyzed. Duplicating parts for a multiplied effect has been held obvious. *St. Regis Paper Co. v. Bemis Co., Inc.*, 193 USPQ 8, 11. Surely, to singularize for a single effect is also obvious. If only one sample is to be analyzed, only one sample well at a time would be provided.

***Status of the Objections and Rejections Applied and Allowability of Claims Indicated in the
Office Action of January 14, 2003***

3. All the objections to the drawings are withdrawn.
4. All the objections to the claims are withdrawn.
5. The rejections of claims 1-5, 9-13, 15, 18, 19, 29-31, 33, and 34 as being obvious under 35 U.S.C. 103(a) over Simpson et al. are maintained.
6. The rejections of claims 6-8 as being obvious under 35 U.S.C. 103(a) over Simpson et al. in view of Zanzucchi et al. are maintained.
7. The allowability of claims 14, 16, 17, 20-28, and 32 is maintained.

Allowable Subject Matter

8. Claims 14, 16, 17, 20, 28, and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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9. Claims 32 and 36-43 are allowed.

10. The following is a statement of reasons for the indication of allowable subject matter:

a) Claims 14, 16, 17, and 20-28 are allowable for the reasons set forth in the Office action of January 14, 2003;

b) Claim 32 is allowable because as seen in Figure 1 of Simpson et al. the lengths of all the functionally identical channels from the various injection points to the anode are not all the same. To have all these lengths the same, as required by claim 32, would require significantly reconfiguring the basic pattern of the wells and channels shown in Figure 1 of Simpson et al.;

c) Claims 35 and 36 are allowable because as seen from Figures 1 and 2 of Simpson et al. the common waste well is located from the injection point at much less than one-half the distance from the injection point to the cathode. To have the common waste well located from the injection point at about one-half the distance from the injection point to the cathode, as required by claims 35 and 36, would require significantly reconfiguring the basic pattern of the wells and channels shown in Figure 1 of Simpson et al.;

d) Claims 38 and 41 are allowable because as seen from Figures 1 and 2 of Simpson et al. the common waste well is located from the injection point at much less than one-half the distance from the injection point to the cathode. To have the common waste well located from the injection point at about the same distance from the injection point to the cathode, as required by claims 38 and 41, would require significantly reconfiguring of the basic pattern of the wells and channels shown in Figure 1 of Simpson et al.;

e) Claim 37 depends from allowable Claim 36;

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- f) Claim 39 depends from allowable Claim 38;
- g) Claim 40 depends from allowable Claim 32; and
- h) Claims 42 and 43 depend directly or indirectly from allowable Claim 41.

Final Rejection

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEX NOGUEROLA whose telephone number is (703) 305-5686. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NAM NGUYEN can be reached on (703) 308-3322. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Alex Nogueroles
Alex Nogueroles
June 6, 2003

Nam Nguyen
NAM NGUYEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700